



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Tfw

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,844	08/06/2001	Shujath M. Ali	DEX-0176	7509
26259	7590	07/13/2005	EXAMINER	
LICATLA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053			YU, MISOOK	
			ART UNIT	PAPER NUMBER
			1642	
DATE MAILED: 07/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
OIFE/AP
JUL 22 2005

NEW CENTRAL FAX NUMBER

Effective July 15, 2005

On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005.

After September 15, 2005, the old number will no longer be in service and **571-273-8300** will be the only facsimile number recognized for "centralized delivery".

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

Office Action Summary	Application No.	Applicant(s)	
	09/787,844	ALI ET AL.	
	Examiner	Art Unit	
	MISOOK YU, Ph.D	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9,13-15,17-19 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9,13-15,17-19 and 21-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/16/05</u> | 6) <input checked="" type="checkbox"/> Other: <u>Exhibit A (sequence alignment)</u> . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/16/2005, and 4/15/2005 has been entered.

Claims 8, 9, 13-15, 17-19, and 21-33 are pending and examined on merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This Office action contains new grounds of objection to the claims.

Claim Objection, Newly Objected

Since claims 13, 17, 21, 22-24, 26, and 27 depend on claim 8 reciting "Pro104" limited to SEQ ID NO: 2, all of the limitations in the rejected dependent claims are the inherent characteristics of SEQ ID NO: 2, thus not further limiting the base claims.

Claim Rejections - 35 USC § 112, Maintained

Claims 8, 9, and 13-15, 17-19, and 21-33 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for the reason of record. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

This rejection is based on the Office's interpretation of the nature of the invention as drawn to a method of imaging of a gynecologic cancer using an monoclonal or polyclonal antibody which specifically binds to SEQ ID NO: 2 (claims 8, 13), wherein said antibody is labeled (claim 9), or method of delivering a derivatized antibody (the specification at page 7 line 14, appears to limit "derivatized" as attaching cytotoxic agent or other art-known agents to an antibody that binds to SEQ ID NO: 2), which specifically binds to SEQ ID NO:2, to a gynecologic cancer cell in vivo (claims 14, 15, 17), or delivering said derivatized antibody to a gynecologic tumor in vivo (Claims 18, 19, 21), wherein new claims 22-27 characterizes that the protein of the base claims to be protease with active domains, or SEQ ID NO:2, wherein the new claims 28-33 specifies various gynecologic cancer.

Applicant argues that instant Pro104 is same as testisin that are highly expressed in ovarian cancers as disclosed by Tang et al., (2005, Cancer Res., vol. 65, pages 868-78, IDS filed on 03/16/2005), and also as disclosed in Papkoff et al (IDS filed on 03/16/2005).

Applicant's arguments and data shown in the poster presentation of Papkoff et al., and the post-filing publication of Tang et al., have been fully considered, but unpersuasive for the following reasons. First, during the prosecution history, the limitation "Pro104" in the instant claims is determined to be limited to the instant SEQ ID NO: 2 protein. See the Office action mailed on 04/21/2004, and applicant's subsequent response, as well as the interpretation of the claims. The specification as originally filed does not reasonably communicates that the protein known in the art, as "testisin" is

Art Unit: 1642

same as the instantly claimed Pro104. The attached sequence alignment aligning the instant SEQ ID NO: 2 against what is the protein known as testisin in the art (Exhibit A) demonstrate that instant SEQ ID NO: 2 is not same as testisin. Therefore, the argument with Tang et al., is not germane to the instantly claimed invention.

As for argument with Papkoff et al., Papkoff et al., discloses the Pro104 is over-expressed in ovarian cancer. However, Papkoff et al., do not establish whether Pro104 is same as the instant SEQ ID NO:2. In fact, one of the figure in the poster, top in the 2nd column appears to indicate that Pro104 in Papkoff et al., is testisin, not instant SEQ ID NO:2. In addition, Papkoff et al., do not establish that whether one could image gynecologic cancers using polyclonal or monoclonal antibody specifically binding to the instant SEQ ID NO:2 encoded by instant SEQ ID NO:1. Papkoff et al., teach that detection of overexpression of Pro104 (testisin) in ovarian cancer tissue samples as compared to normal ovarian tissue.

As stated before in the two previous Office actions, Aloj et al., (2002, Biopolymers. Vol. 66, pages 370-80) teach that in order to target specific molecules inside the body using radiopharmaceuticals such as a radioisotope-labeled antibody, several parameters have to be considered: (1) the target protein should be over-expressed in cancer to be imaged; (2) a radiopharmaceutical should be tested to see whether said radiopharmaceutical specifically binds to the *in vivo* target *in vivo*; (3) how the unbound radiopharmaceutical is cleared for minimizing unwanted high background (note the abstract, and pages 372-373). The instant specification has failed to teach with a reasonable certainty that the protein encoded by SEQ ID NO:1 is a gynecologic

Art Unit: 1642

cancer antigen while the art (see Hooper et al., above) suggests that the protein encoded by SEQ ID NO:1 is a tumor suppressor. Low et al., (1995, Radiology, vol. 195, pages 391-400) also teach that in order to image an ovarian cancer (a species of a gynecologic cancer), selection of an antibody that specially binds to an ovarian cancer-associated antigen, is the first necessary step (see page 391 middle column; the authors selected an antibody targeting Tag-72, a previously known ovarian cancer antigen). Low et al., further teach accuracy of imaging using an antibody directed to a cancer antigen has to be evaluated against other known cancer detection methods such as histology or pathology (note page 393 under the heading "Pathologic Proof", and Table 3 at page 396). Likewise, Krag et al., (1993, Arch. Surg. Vol. 128, pages 819-23) teach method of imaging an ovarian cancer using a radio-labeled (i.e. indium 111-labeled) CYT-103 monoclonal antibody requires selection of an antibody capable of binding to an antigen that is over-expressed in an ovarian cancer (see page 820 under the heading "Patients, Materials, and Methods").

Considering the unpredictable state of art, limited guidance, no examples in the specification how to use the instantly claimed invention, broad breath of the claims, it is concluded that undue experimentation is required to practice the invention.

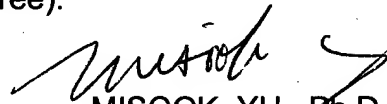
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

Art Unit: 1642

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MISOOK YU, Ph.D
Examiner
Art Unit 1642



Sheet 01 of 01

Form PTO-1449 Modified

Docket No.
DEX-0176Serial No.
09/787,844List of Patents and Publications
Cited by Applicant
(Use several sheets if necessary)Applicant
Ali and Cafferkey

U.S. Department of Commerce

Filing Date
August 6, 2001Group
1642

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

my	CA	Papkov et al Abstract Number A215 presented on November 18, 2003 at the AACR-NCI-EORTC 2003 International Conference on "Molecular Targets and Cancer Therapeutics discovery, biology and clinical applications".
↓	CB	Tang et al., "Testisin, a Glycosyl-Phosphatidylinositol-Linked Serine Protease, Promotes Malignant Transformation In vitro and In vivo", Cancer Res. 2005 65(3):868-878
EXAMINER	Miss Y	
DATE CONSIDERED	7-8-05	

Exhibit A

272

RA Vanden R., Watanabe C., Wisaand D., Woods K., Xie M.-H., Yaneura D.,
RA Yi S., Yu G., Yuan J., Zhang M., Zhang Z., Goddard A., Wood N.I.,
RA "The secreted protein discovery initiative (SPDI), a large-scale
RT effort to identify novel human secreted and transmembrane proteins: a
RT bioinformatics assessment.",
RL Genome Res. 13:2265-2270(2003).
CC -1- FUNCTION: Could regulate proteolytic events associated with
CC testicular germ cell maturation.
CC -1- SUBCELLULAR LOCATION: Attached to the membrane by a GPI-anchor
CC (Potential).
CC -1- ALTERNATIVE PRODUCTS:
CC Event-Alternative splicing; Named isoforms=3;
CC Name=1; Synonyms=L;
CC IsoId=Q9Y6M0-1; Sequence=Displayed;
CC Name=2; Synonyms=S;
CC IsoId=Q9Y6M0-2; Sequence=VSP_005389;
CC Name=3;
CC IsoId=Q9Y6M0-3; Sequence=VSP_005390;
CC -1- TISSUE SPECIFICITY: Expressed predominantly in premeiotic
CC testicular germ cells, mostly late pachytene and diplotene
CC spermatocytes.
CC -1- SIMILARITY: Belongs to peptidase family S1.

CC This SWISS-PROT entry is copyright. It is produced through a collaboration
CC between the Swiss Institute of Bioinformatics and the EMBL outstation
CC the European Bioinformatics Institute. There are no restrictions on its
CC use by non-profit institutions as long as its content is in no way
CC modified and this statement is not removed. Usage by and for commercial
CC entities requires a license agreement (See <http://www.isb-eb.ch/announce/>
CC or send an email to license@isb-sib.ch).

DR EMBL; AF058300; AAD41588.1; -
DR EMBL; AB031329; BAA83520.1; -
DR EMBL; AB031330; BAA83521.1; -
DR EMBL; AB031331; BAA89332.1; -
DR EMBL; AF058301; AAF79019.1; -
DR EMBL; AF058302; AAF79020.1; -
DR HSSP; P00763; IDPO.
DR MEROPS; S01.011; -
DR GENE; HGNC:9485; PRS921.
DR GO; GO:0005737; Cytoplasm; TAS.
DR GO; GO:0005624; C-membrane fraction; TAS.
DR GO; GO:0005886; C-plasma membrane; TAS.
DR GO; GO:0008236; F-actin-type peptidase activity; TAS.
DR InterPro; IPR009003; Cys_Ser_trypsin.
DR InterPro; IPR001234; Peptidase_S1.
DR Pfam; PF00089; trypsin; 1.
DR PRINTS; PR00722; CHYMOTRYPSIN.
DR SMART; SM00020; TRYP_SPC; 1.
DR PROSITE; PS00240; TRYP_SIN_DOM; 1.
DR PROSITE; PS00134; TRYP_SIN_HIS; 1.
DR PROSITE; PS00135; TRYP_SIN_SSR; 1.
KW Hydrolase; Serine protease; Glycoprotein; Signal; GPI-anchor; Zymogen;
KW Alternative splicing; Lipoprotein.
FT SIGNAL 1 19 POTENTIAL.
FT PROPEP 20 41 POTENTIAL.
FT CHAIN 42 288 POTENTIAL.
FT PROPEP 289 314 REMOVED IN MATURE FORM (POTENTIAL).
FT ACT_SITE 82 82 CHARGE RELAY SYSTEM (POTENTIAL).
FT ACT_SITE 137 137 CHARGE RELAY SYSTEM (POTENTIAL).
FT ACT_SITE 238 238 CHARGE RELAY SYSTEM (POTENTIAL).
FT DISULFID 33 157 POTENTIAL.
FT DISULFID 67 83 POTENTIAL.
FT DISULFID 171 244 POTENTIAL.
FT DISULFID 204 223 POTENTIAL.
FT DISULFID 234 262 POTENTIAL.
FT LIPID 288 288 GPI-anchor amidated serine (Potential).
FT FT CARBOHYD 167 167 N-LINKED (GLCNAc...) (POTENTIAL).
FT FT CARBOHYD 200 200 N-LINKED (GLCNAc...) (POTENTIAL).

FT CARBOHYD 273 273 N-LINKED (GLCNAc...) (POTENTIAL).
FT VARSPLIC 67 88 Missing (in isoform 2).
FT VARSPLIC 222 235 Missing (in isoform 3).
FT VARSPLIC 222 235 Missing (in isoform 3).
SQ SEQUENCE 314 AA; 34884 MW; E738CF73F6B56E98 CRC64;
Query Match 96.4%; Score 1728; DB 1; Length 314;
Best Local Similarity 100.0%; Pred. No. 1.28-147;
Matches 314; Conservative 0; Mismatches 0; Indels 0; Gaps 0;
QY 14 MGARGALLALLARACLRKPEQEAAPLSGPGRRVITSRVGGEDAEELGRWPGQSLR 73
DB 1 MGARGALLALLARACLRKPEQEAAPLSGPGRRVITSRVGGEDAEELGRWPGQSLR 60
QY 74 LWDSHVCGVLSHRWALTAHCFETYSLSDPGSGWVQPGQLTSMPSFSLQAYTRYF 133
DB 61 LWDHVCVLSHRWALTAHCFETYSLSDPGSGWVQPGQLTSMPSFSLQAYTRYF 120
QY 134 VNTYLSRYLGNSPYDIALVLSAPVYTKHIOFICLOASTFEPENTDCWVTGWYIK 193
DB 121 VNTYLSRYLGNSPYDIALVLSAPVYTKHIOFICLOASTFEPENTDCWVTGWYIK 180
QY 194 EDEALPSPTLQEQVQVAIINNSMCNHLFLKY9FRKDIIFGDMVYACGAGKXGACFGDSGG 253
DB 181 EDEALPSPTLQEQVQVAIINNSMCNHLFLKY9FRKDIIFGDMVYACGAGKXGACFGDSGG 240
QY 254 PLACNKGWLYQICVGVGCGRPNRPGVYTNISHHFENIQKMAQSGNSQPPSPWPLL 313
DB 241 PLACNKGWLYQICVGVGCGRPNRPGVYTNISHHFENIQKMAQSGNSQPPSPWPLL 300
QY 314 FFFLLMALPLPGPV 327
DB 301 FFFLLMALPLPGPV 314

RESULT 2
TEST MOUSE STANDARD; PR: 324 AA.

AC Q9JH37; Q9DA14;
DT 16-OCT-2001 (Rel. 40, Last sequence update)
DT 18-OCT-2001 (Rel. 40, Last sequence update)
DT 15-MAR-2004 (Rel. 43, Last annotation update)
DE Testis; precursor (EC 3.4.21.-) (tryptase 4).
GN PRS921.
OS Mus musculus (Mouse).
OC Eukaryota; Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi;
OC Mammalia; Eutheria; Rodentia; Sciurognathi; Muridae; Murinae; Mus.
OX NCBI_TaxId=10090;
RN [1]
RP SEQUENCE FROM N.A.
RC STRAIN=129/SV;
RX MEDLINE=1231276; PubMed=1231276;
RA Scarman A.L., Hooper J.D., Boucaut K.J., Sit M.-L., Webb G.C.,
RA Normyle J.F., Antalis T.M.,
RT "Organization and chromosomal localization of the murine Testis gene
RT encoding a serine protease temporally expressed during
RT spermatogenesis.",
RL Eur. J. Biochem. 268:1250-1258(2001).
RN [2]
RP SEQUENCE FROM N.A.
RC STRAIN=BAUB/c; TISSUE=Testis;
RX PubMed=11259427;
RA Wong G.W., Li L., Madhusudhan M.S., Krilis S.A., Gurish M.F.,
RA Rothenberg M.B., Sali A., Stevens R.L.,
RT "Tryptase 4, a new member of the chromosome 17 family of mouse serine
RT proteases.",
RL J. Biol. Chem. 276:20648-20658(2001).
RN [3]
RP SEQUENCE OF 3-324 FROM N.A.
RC STRAIN=C57BL/6J; TISSUE=Testis;
RX MEDLINE=21085660; PubMed=2112785;
RA Kawai J., Shinagawa A., Shibata K., Yoshino M., Itoh M., Ishii Y.,

Organization **IC1600** Bldg./Room **REMPSEN**

U. S. DEPARTMENT OF COMMERCE

COMMISSIONER FOR PATENTS

P.O. BOX 1450

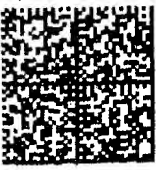
ALEXANDRIA, VA 22313-1450

IF UNDELIVERABLE RETURN IN TEN DAYS

OFFICIAL BUSINESS

AN EQUAL OPPORTUNITY EMPLOYER

UNITED STATES PO
02 1A
00042044
MAILED FR



IX

A ☒ INSUFFICIENT ADDRESS
C ☐ ATTEMPTED NOT KNOWN
S ☐ NO SUCH NUMBER/ STREET
☐ OTHER
☐ NOT DELIVERABLE AS ADDRESSED
☐ UNABLE TO FORWARD

RTS
RETURN TO SENDER

RECEIVED
JUL 22 2005
USPS MAIL CENTER